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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,875	09/25/2000	Jerry Freestone	NTL-3.2.133/3405 (12052SC)	3055
35437	7590	03/29/2006	EXAMINER WON, MICHAEL YOUNG	
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO 666 THIRD AVENUE NEW YORK, NY 10017			ART UNIT 2155	PAPER NUMBER

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,875

Applicant(s)

FREESTONE ET AL.

Examiner

Michael Y. Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-45 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the Request for Continued Prosecution filed February 15, 2006.
2. Claims 1, 8, and 24 have been amended.
3. Claims 1-45 have been examined and are pending with this action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of claims 1 and 8 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The applicant(s) claim "An electronic message comprising: a sound file" and "A method for sending e-mail", respectively, but does not define within the body of the

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claim the hardware in which the invention runs. Thus, absent recitation of the client, server or some other hardware, claim 1 is not limited to a tangible embodiment, instead being sufficiently broad to encompass software, per se.

Claim 1 states a sound file and identifiers associated with the sound file and claim 8 states attaching a sound file and utilizing an identifier associated with the sound file. Both claims do not produce a tangible result.

Overall, the claimed invention as a whole must accomplish a practical application. That is it must produce a **“useful, concrete, and tangible result”**. See State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106

Claim Rejections - 35 USC § 112

5. Claims 1, 8, and 24 previously rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10, 12-19, 21-31, 33-41, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al. (US 5,732,216 A).

INDEPENDENT:

As per **claim 1**, Logan teaches an electronic message comprising: sound file (see col.42, line 67 to col.43, line 2); and, predetermined identifier that distinguishes said sound file from other files attached to the message (see col.5, line 63-col.6, line 8; col.11, lines 4-15; col.15, lines 12-19; and col.45, lines 52-54) and indicates a course of action to be taken with said sound file (see col.2, lines 38-40; col.5, line 63-col.6, line 8; and col.7, lines 36-41).

As per **claim 8**, Logan teaches a method for sending an e-mail comprising: attaching a sound file to an e-mail (see col.42, line 67 to col.43, line 2); and utilizing a predetermined identifier which distinguishes said sound file from other files attached to the e-mail (see col.5, line 63-col.6, line 8; col.11, lines 4-15; col.15, lines 12-19; and col.45, lines 52-54) and which indicates a course of action to be taken with said sound file (see col.2, lines 38-40; col.5, line 63-col.6, line 8; and col.7, lines 36-41).

As per **claim 24**, Logan teaches a method for announcing electronic messages comprising: receiving an electronic message with an attached sound file (see col.42, line 67 to col.43, line 2); noting the presence of a predetermined identifier that distinguishes said sound file from other files attached to the message (see col.5, line 63-col.6, line 8; col.11, lines 4-15; col.15, lines 12-19; and col.45, lines 52-54); and,

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playing the attached sound file in response to the noting of the predetermined identifier (see col.1, lines 42-46 and col.7, lines 36-41).

DEPENDENT:

As per **claims 2-4, 14-16, and 26-28**, Logan further teaches wherein said sound file contains at least one word in a computer-simulated voice and at least one word in a sender's voice (see col.28, lines 19-26).

As per **claim 5**, Logan further teaches wherein the predetermined identifier is a specific file name associated with said sound file (see col.5, lines 6-15).

As per **claims 6, 17, and 29**, Logan further teaches wherein the predetermined identifier is an information tag (see col.44, lines 12-15).

As per **claims 7, 18, and 30**, Logan further teaches wherein the information tag is embedded in the e-mail header (see col.43, lines 5-15).

As per **claim 9**, Logan further teaches wherein said attaching, is performed by a computer at a sending party's end (see col.15, lines 15-19).

As per **claim 10**, Logan further teaches wherein said attaching is automatic (see col.10, lines 28-36).

As per **claim 12**, Logan further teaches wherein said attaching, is performed by an e-mail server (see col.4, lines 40-46 and col.6, lines 39-41).

As per **claim 13**, Logan further teaches wherein said attaching is, performed by a recipient computer (see col.2, lines 10-14 and col.15, lines 15-19).

As per **claims 19 and 31**, Logan further teaches wherein the information tag, is embedded by a sender computer (see col.43, lines 26-33 & 46-60 and col.44, lines 12-15).

As per **claims 21 and 33**, Logan further teaches wherein the information tag, is embedded by an e-mail server (see claim 7 and 19 rejection above).

As per **claim 22 and 34**, Logan further teaches wherein the information tag, is embedded by a recipient computer (see claim 13 and 19 rejection above).

As per **claim 23**, Logan further teaches wherein said attaching, is selectively performed by a sending party (see col.11, lines 27-34).

As per **claim 25**, Logan teaches of further comprising receiving at least one more electronic message with an attached sound file and playing said at least one more sound file (see col.7, lines 51-61).

As per **claim 35**, Logan further teaches wherein said playing is selective (see col.46, lines 26-28).

As per **claim 36**, Logan further teaches wherein said playing is performed at a recipient computer (see col.1, lines 42-49).

As per **claim 37**, Logan further teaches wherein said playing is performed at recipient customer premise equipment (see col.1, lines 42-49)

As per **claim 38**, Logan further teaches where said playing is performed at a recipient voice mail (see col.15, lines 31-46).

As per **claim 39**, Logan teaches of further comprising converting the content of the electronic message to a voice message (see col.28, lines 19-26).

As per **claim 40**, Logan further teaches where said converting is performed at an e-mail server (see col.5, lines 26-31).

As per **claim 41**, Logan further teaches where said converting is performed at a recipient computer (see col.5, lines 16-26).

As per **claim 44**, Logan further teaches wherein said converting is performed using a sound file as a voice sample.

As per **claim 45**, Logan teaches of further comprising transferring said voice message to a voice mailbox (see col.15, lines 31-46 and col.29, lines 36-41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11, 20, 32, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. (US 5,732,216 A) in view of Agraharam et al. (US 6,085,231 A).

As per **claims 11, 20, 32, and 42**, Logan further teaches wherein said attaching is performed by a computer at a sending party's end (see claim 9 rejection above), wherein the information tag is embedded by a computer at a sending party's end (see

claim 7 rejection above), and wherein said converting is performed at a computer at the receiving party's end.

Logan does not explicitly teach of an adjunct to a sender or a receiver for performing these steps. Agraharam teaches of an adjunct (see col.3, lines 20-29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Agraharam within the system of Logan by implementing adjunct devices or means for performing each function by means of adjunct devices or servers or the like within the method for sending an e-mail or announcing and electronic message because Agraharam teaches that a subscriber can retrieve both their voice-mail and e-mail messages by accessing only their e-mail (see abstract) and Logan teaches comments could be transmitted via an e-mail as an attachment (see col.42, line 67-col.43, line 2). Therefore, if an attachment of an e-mail was to be retrieved that contained comments/voicemail, one would readily employ an e-mail server that is "part of or adjunct" to the ISP (see Agraharam col.3, lines 20-25).

As per **claim 43**, Logan does not explicitly teach wherein said converting is performed at a voice messaging system. Agraharam teaches wherein said converting is performed at a voice messaging system (see Fig.2, #202 & #206 and col.4, lines 7-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Agraharam within the system of Logan by implementing conversion to be performed at a voice messaging system within the method for sending an e-mail or announcing and electronic message because Logan

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teaches of voice messages (see col.29, lines 39) and explains how conversion is preferable at the client station to quickly download text files rather than audio files which are larger thus increasing transmission time (see col.5, lines 16-26).

Response to Arguments

8. Applicant's arguments filed February 15, 2006 have been fully considered but they are not persuasive.

A. Applicant(s) argue that the rejection under 35 U.S.C. 112, 1st paragraph rejection for failing to comply with the written description requirement was improper and that the rejection be withdrawn.

The examiner has withdrawn this previous rejection under 35 U.S.C. 112, 1st paragraph (see item 5. above).

B. Applicant(s) argue that the cited reference locations of U.S. Pat. No. 5,732,216 (*Logan et al.*) do not teach, "predetermined identifier which distinguishes said sound file from other files attached to the e-mail" as recited in claim 8 and similarly recited in claims 1 and 24.

In column 15, lines 12-19, *Logan* teaches of program segments (recorded as Program_ID) may be recalled and all or part may be saved for future reproduction or transmission as an attachment. Clearly, it is inherent that the segments are

distinguished over other segments, by the Program_ID, otherwise, future reproduction would not be possible. In column 45, lines 52-54, *Logan* teach in the claim that the identification data includes the specification of a position to which an annotation relates. Again, *Logan* is teachings a distinguishing characteristic of a given data referenced by an identification data. Additional reference locations have been provided to explicitly teach of distinguishing the data among other data by means of an identifier.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Furthermore, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. See *In re American Academy of Science Tech Center*, F.3d 2004 WL 1067528 (Fed. Cir. May 13, 2004).

C. The applicant(s) argue that the combination of references *Logan* and U.S Pat. No. 6,259,444 (*Palmer et al.*) in the previous office action is improper.

This argument is moot. The examiner has concluded that *Logan* teaches all the limitations of the broadly claimed invention and thus *Palmer* is not relied upon.

For the reasons above all dependent claims remain rejected.

Conclusion

9. Claims 1-45 have been rejected and remain pending.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



March 23, 2006